

ESTTA Tracking number: **ESTTA267236**

Filing date: **02/18/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Burt's Bees, Inc.
Granted to Date of previous extension	02/18/2009
Address	701 Distribution Drive Durham, NC 27709 UNITED STATES
Attorney information	Joseph H. Nanney Wyrick Robbins Yates & Ponton LLP 4101 Lake Boone Trail, Suite 300 P.O. Drawer 17803 Raleigh, NC 27619 UNITED STATES jnanney@wyrick.com, srijo@wyrick.com Phone:(919) 781-4000

Applicant Information

Application No	77470267	Publication date	10/21/2008
Opposition Filing Date	02/18/2009	Opposition Period Ends	02/18/2009
Applicant	Heather Bees 2173 Ocean Way Laguna Beach, CA 92651 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Lip balm, lip gloss, body washes, bath soap, bath salts, body lotion, bath lotion, body creams, cocoa butter for cosmetic purposes, facial cleanser, exfoliant creams, toners, beauty mask, body mask, skin emollients, skin moisturizer, hair shampoo, hair conditioners, hair nourishers, non-medicated skin care preparations, non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2171302	Application Date	06/16/1997
Registration Date	07/07/1998	Foreign Priority	NONE

		Date	
Word Mark	BURT'S BEES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1988/03/27 First Use In Commerce: 1988/03/27 cosmetics and skin care products, namely, cremes, oils, soaps, moisturizers, lotions, lip balms and glosses, shaving lotions, shaving balms, and colognes		

Attachments	Notice of Opposition 02-18-09.pdf (5 pages)(448771 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Joseph H. Nanney/
Name	Joseph H. Nanney
Date	02/18/2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BURT'S BEES, INC.,)	
)	
Opposer,)	Opposition No. _____
)	
v.)	
)	
)	
HEATHER BEES, LLC,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Opposer Burt's Bees, Inc. ("Opposer") believes that it will be damaged by registration of the mark HEATHER BEES ("Applicant's Mark") with those goods and services listed in application Serial No.77/470,267 (the "Application") filed by Heather Bees, LLC ("Applicant"). Opposer requests that registration to Applicant of Applicant's Mark be refused. In support of its opposition, Opposer asserts as follows:

THE PARTIES

1. Opposer Burt's Bees, Inc. is a Delaware Corporation, with an office and place of business located at 701 Distribution Drive, Durham, North Carolina 27709.
2. Applicant Heather Bees, LLC, upon information and belief, is a California limited liability company with an office and place of business at 2173 Ocean Way, Laguna Beach, California 92651.

OPPOSER'S MARKS, GOODS AND SERVICES, AND NOTORIETY

3. Opposer is an industry leader in natural cosmetics including skin care, hair care and lip balm sold under the well-known and famous BURT'S BEES brand that includes a family of marks using the "bees" and "bee" terms.

4. Opposer owns, among others, the “bees” and “bee” family trademarks (collectively, “Opposer’s Marks”) listed in Table “A” below:

Table “A”: Opposer’s Marks

<u>MARK</u>	<u>REGISTRATION NUMBER</u>	<u>GOODS/SERVICES</u>	<u>STATUS</u>
BURT’S BEES	2,171,302	cosmetics and skin care products, namely, cremes, oils, soaps, moisturizers, lotions, lip balms and glosses, shaving lotions, shaving balms, and colognes	Registered on July 7, 1998 and renewed on October 29, 2007
BURT’S BEES	3,356,042	Online retail store services featuring cosmetics, skin care products, hair care products, perfumery and toiletry products	Registered on December 18, 2007
BURT’S BEESWAX	3,358,973	Cosmetics and skin care products containing beeswax, namely, lip balms, lip glosses and crèmes	Registered on December 25, 2007
BABY BEE	2,169,521	cosmetics and skin care products, namely, cremes, oils, soaps, powders, milk baths, emollient baths, fragranced baths, moisturizing baths, non-medicated milk soaks, non-medicated emollient soaks, non-medicated fragranced soaks, non-medicated moisturizing soaks, moisturizers, gels, lotions, and conditioners	Registered on June 30, 1998 and renewed on October 30, 2007
BABY BEE PLUS DESIGN	2,173,051	cosmetics and skin care products, namely, cremes, oils, soaps, powders, milk baths, emollient baths, fragranced baths, moisturizing baths, non-medicated milk soaks, non-medicated emollient soaks, non-medicated fragranced soaks, non-medicated moisturizing soaks, moisturizers, gels, lotions, and conditioners	Registered on April 21, 1998 and renewed on October 30, 2007
MAMA BEE	3406032	skin care products, namely, oils, lotions and cremes for the body	Registered on April 1, 2008

4. Opposer has continuously and exclusively used Opposer’s Marks in connection with the above goods and services (“Opposer’s Goods and Services”) listed in Table “A” above.

5. In particular, Opposer has used the BURT’S BEES mark for over 20 years since March 1988 for “cosmetics and skin care products, namely, cremes, oils, soaps, moisturizers, lotions, lip balms and glosses, shaving lotions, shaving balms, and colognes.”

6. Opposer has sold millions of dollars worth of cosmetics under Opposer’s Marks, including the BURT’S BEES mark.

7. Opposer has expended substantial resources in advertising and protecting Opposer's Goods and Services offered under Opposer's Marks.

8. Specifically, the BURT'S BEES and BABY BEE marks have become famous in the United States based on each mark's substantial use and popularity with consumers.

9. Opposer's Marks have come to represent and symbolize extremely valuable goodwill belonging exclusively to Opposer.

APPLICANT'S MARK, GOODS AND SERVICES

10. Applicant filed the Application to register the mark HEATHER BEES on May 9, 2008 based upon Applicant's intent to use Applicant's Mark in commerce.

11. Applicant's Mark was published for opposition in the Official Gazette on October 21, 2008, and assigned serial number 77/470,267.

12. The goods and services listed in the Application are "Lip balm, lip gloss, body washes, bath soap, bath salts, body lotion, bath lotion, body creams, cocoa butter for cosmetic purposes, facial cleanser, exfoliant creams, toners, beauty mask, body mask, skin emollients, skin moisturizer, hair shampoo, hair conditioners, hair nourishers, non-medicated skin care preparations, non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels" ("Applicant's Goods and Services").

OPPOSER'S CLAIMS

CLAIM 1: LIKELIHOOD OF CONFUSION

13. Opposer's Marks are distinctive for each of Opposer's Goods and Services.

14. Opposer has continuously used Opposer's Marks in connection with Opposer's Goods and Services since the first use dates claimed in each such application and registration.

15. Opposer has not abandoned Opposer's Marks in connection with any of Opposer's Goods and Services.

16. As a result of Opposer's extensive use and promotion of Opposer's Marks, those marks have come to represent and symbolize extremely valuable goodwill belonging exclusively to Opposer.

17. Opposer's Mark and Applicant's Mark are highly similar – BURT'S BEES and HEATHER BEES.

18. Applicant's Goods and Services are highly related to Opposer's Goods and Services.

19. In view of the similarity between the BURT'S BEES and the HEATHER BEES marks and the related nature of the goods and services of the respective parties, Applicant's Mark so resembles Opposer's Mark previously used and registered in the United States as to be likely to cause confusion, or to cause mistake or to deceive.

20. Persons familiar with Opposer's Marks are likely to believe erroneously that Applicant's Goods and Services are offered by Opposer or are authorized, licensed, endorsed, or sponsored by Opposer.

21. Opposer's rights in Opposer's Marks are superior to any rights Applicant may claim, in particular with respect to the BURT'S BEES mark that has been in use for 20 years before any date that the Applicant may claim.

22. The registration of Applicant's Mark would prevent Opposer from exercising exclusive control over the goodwill and reputation associated with Opposer's Mark.

23. As a result, the registration of Applicant's Mark would cause damage and injury to Opposer and to the public.

CLAIM 2: DILUTION

24. Opposer's Marks, including the BURT'S BEES mark, are distinctive and famous.

25. Opposer's Marks, including the BURT'S BEES mark, became distinctive and famous prior to Applicant filing the Application on May 9, 2008.

26. Registration of Applicant's HEATHER BEES mark is likely to impair the distinctiveness of Opposer's Marks by eroding the public and the consumer's exclusive identification of these marks with Opposer, and lessening the capacity of the marks to identify and distinguish the goods and services.

REQUEST FOR RELIEF

WHEREFORE, Opposer requests that the opposition be sustained and that registration of the mark HEATHER BEES to Applicant be refused.

Respectfully submitted this 18th day of February, 2009.

WYRICK ROBBINS YATES & PONTON LLP

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